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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/715,035	11/17/2003	John J. Giobbi	MD-1-CIP2	2770
21186	7590	03/24/2005	EXAMINER	
SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402			ZAND, KAMBIZ	
			ART UNIT	PAPER NUMBER
			2132	

DATE MAILED: 03/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/715,035

Applicant(s)

GIOBBI, JOHN J.

Examiner

Kambiz Zand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 November 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-26 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-26 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 17 November 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/17/2003.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. **Claims 1-26** have been examined.
2. Foreign Priority benefit claimed under Title 35, United States Code, § 120 have been acknowledged.

### ***Information Disclosure Statement PTO-1449***

3. The Information Disclosure Statement submitted by applicant on 11/17/2003 has been considered. Please see attached PTO-1449.

### **Drawings**

4. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "physical key" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Correction is required.
5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description:  
Example: "key" in fig. 1, step 10 or similar steps or blocks in the drawings. Correction of all similar errors is requested.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Example " physical electronic key" page 6, line 24; " physical key" page 6, line 30 respectively. Corrections of all similar errors are requested.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 9, 17 and 22, the "detecting ...physical key." phrases makes the claims indefinite and unclear in that neither means/method steps nor interrelationship of means/method steps are set forth in these claims in order to achieve the desired results expressed in the "detecting...physical key" phrases.

In claims 1, 9, 17 and 22, the "physical key." phrases makes the claims indefinite and unclear. It is not clear if the invention involves a true physical key (disclosed in the

claims and specification) or a generated key using software as it is shown in the drawings. Examiner considers the latter for the purpose of examinations.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1-2, 4, 7-10, 12, 15-19, 21-24 and 26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (6,385,596 B1) in view of Paget (The security behind Secure Extranets, Enterprise System Journal, 14, 12, 74, December 1999).

11. **As per claims 1 and 9** Wiser et al (6, 385, 596 B1) teach a method, system of securing a hard drive (see fig.1b, blocks 106, 120 and 130; col.4, lines 3-13) of a computer, comprising: detecting a key with a receiver/decoder circuit associated with the hard drive; validating the detected key with the receiver/decoder circuit; and permitting access to the hard drive or a portion thereof with the receiver/decoder circuit if the detected key is validated (see col.3, lines 5-10; col.4, lines 15-18 where the passport corresponds to Applicant's key; col.4, lines 12-27, 51-67; col.5, lines 11-17;

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col.8, lines 46-56 where decryption process is being done and where the decoding or decrypting circuit is inherent part of the system in order to do the decoding and decryption; Also see the entire reference for more detail) but do not explicitly disclose the key is a physical, portable key. However Paget (The security behind Secure Extranets, Enterprise System Journal, 14, 12, 74, December 1999) disclose the key is a physical portable key (see the entire reference pages with close attention to where the passport and digital certificate that contains the key are installed on a smart card on the second page where examiner considers such smart card as corresponding to Applicant's physical, portable key). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Paget's portable key such as the smart card in Wiser's secure access to on-line music files on the storage (hard disk) in order to extends extranet access and authority to users based on their roles and business privileges, while ensuring confidentiality and integrity of the data users send, receive and access.

12.

**As per claims 17 and 22** Wiser et al (6,385,596 B1) teach a method, system of securing and accessing a computer file (see fig.1b, blocks 106, 120 and 130; col.4, lines 3-13; abstract), comprising: encrypting the file with a receiver/decoder circuit using a key; storing the encrypted file on a storage medium; requesting the file with a playback mechanism; detecting the key with the receiver/decoder circuit; validating the detected key with the receiver/decoder circuit; and if the detected key is validated, decrypting the file with the receiver/decoder circuit using the detected key, whereby the decrypted file

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can be played back with the playback mechanism (see abstract; fig. 2 and 4 and associated text; col.3, lines 5-10; col.4, lines 15-18 where the passport corresponds to Applicant's key; col.4, lines 12-27, 51-67; col.5, lines 11-17; col.8, lines 46-56 where decryption process is being done and where the decoding or decrypting/encryption or encoding circuit is inherent part of the system since the fig.2 and 4 and associated text disclose the act of encryption and decryption; Also see the entire reference for more detail) but do not explicitly disclose the key is a physical, portable key. However Paget (The security behind Secure Extranets, Enterprise System Journal, 14, 12, 74, December 1999) disclose the key is a physical portable key (see the entire reference pages with close attention to where the passport and digital certificate that contains the key are installed on a smart card on the second page where examiner considers such smart card as corresponding to Applicant's physical, portable key). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Paget's portable key such as the smart card in Wiser's secure access to on-line music files on the storage (hard disk) in order to extends extranet access and authority to users based on their roles and business privileges, while ensuring confidentiality and integrity of the data users send, receive and access.

**As per claims 2 and 10** Wiser et al (6, 385, 596 B1) teach the method, system of claims 1 and 9, wherein the receiver/decoder circuit resides in the computer (see fig.9b-13 and associated text).

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**As per claims 4 and 12** Wiser et al (6, 385, 596 B1) teach the method, system of claims 1 and 9, wherein the validating step includes determining whether or not the detected key is associated with the hard drive (see fig.1b and associated text; col.3, lines 37-39; col.5, lines 11-17; col.18, lines 66-67 and col.19, lines 1-25).

**As per claims 7 and 15** Wiser et al (6, 385, 596 B1) teach the method, system of claims 4 and 12, wherein digital content read from or written to the hard drive is decrypted or encrypted by the receiver/decoder circuit using the key associated with the hard drive in order to provide sector-level protection (see col.6, lines 4-65; fig.9b and associated text where the storing corresponds to applicant's write and retrieving media files corresponds to applicant's read).

**As per claims 8 and 16** Wiser et al (6, 385, 596 B1) teach the method, system of claims 4 and 12, wherein the key associated with the hard drive is initially delivered with the hard drive (see fig.2-4 and associated text).

**As per claims 18 and 23** Wiser et al (6, 385, 596 B1) teach the method, system of claims 17 and 22, wherein the storage medium is a hard drive of a computer, and the receiver/decoder circuit resides in the computer (see fig.1b; 2 and associated text).

**As per claims 19 and 24** Wiser et al (6, 385, 596 B1) teach the method, system of claims 17 and 22, wherein a software driver in the computer's operating system



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instructs the receiver/decoder circuit to perform the detecting, validating, and decrypting steps (see abstract; col.3-4).

**As per claims 21 and 26** Wiser et al (6, 385, 596 B1) teach the method, system of claims 17 and 22, wherein the validating step includes determining whether or not the detected key is associated with the file (fig.1b, 2 and associated text; col.3-4).

13. **Claims 3, 11, 20 and 25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Wiser et al (6,385,596 B1) in view of Paget (The security behind Secure Extranets, Enterprise System Journal, 14, 12, 74, December 1999); and further in view of Hasegawa (6,632,992 B2).

**As per claims 3, 11, 20 and 25** Wiser et al (6, 385, 596 B1) in view of Paget (The security behind Secure Extranets, Enterprise System Journal, 14, 12, 74, December 1999) teach all limitation of the method, system of claims 1, 9, 17 and 22 as applied above but do not explicitly disclose wireless communication. However Hasegawa (6,632,992 B2) wireless communication (see col.3, lines 22-39). It would have been obvious to one of ordinary skilled in the art at the time the invention was made to utilize Hasegawa's wireless communication in Wiser's secure access to on-line music files on the storage (hard disk) in view of Paget's portable key such as the smart card in order to extends extranet access and authority to users based on their roles and business

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privileges, while ensuring confidentiality and integrity of the data users send, receive and access without the use of wires or cables.

***Allowable Subject Matter***

14. **Claims 5-6 and 13-14** would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

**Conclusion**

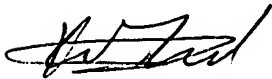
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Please see related art cited by Examiner in PTO-892

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kambiz Zand whose telephone number is (571) 272-3811. The examiner can normally be reached on Monday-Thursday (8:00-5:00). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron can be reached on (571) 272-3799. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published

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applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kambiz Zand

03/17/2005